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IN THE

Supreme Court of the United States

OCTOBER TERM, 1941.

No. 761.

ELECTRO METALLURGICAL COMPANY, FREDERICK M. BECKET and RUSSELL FRANKS,
Petitioners,

vs.

KRUPP NIROSTA COMPANY, INC.,
Respondent.

BRIEF ON BEHALF OF RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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KRUPP NIROSTA COMPANY, INC.,

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Brief on Behalf of Respondent in Opposition to Petition for Writ of Certiorari.

The petition for writ of certiorari raises no question of Constitutionality, no question of jurisdiction, no question of conflict of decisions, no question of local law, no question of Federal law not heretofore settled by decisions of this court, no question of a departure from accepted and usual course of judicial proceedings.

The law applied by the Circuit Court of Appeals in this case with respect to *ex parte* tests in patent cases is laid down by the United States Supreme Court in *Carnegie Steel Co.* v. *Cambria Iron Co.*, 185 U. S. 403, 420, and has been uniformly followed by the lower courts in many decisions.

Plunger Elevator Co. v. *Standard Plunger E. Co.*, 165 Fed. 906, 911 (C. C. A. First);

Chadeloid Chemical Co. v. *Wilson*, 224 Fed. 481 (C. C. A. Second);

Bethlehem Steel Co. v. *Niles-Bement-Pond Co.*, 166 Fed. 880; affirmed 173 Fed. 1019 (C. C. A. Third);

Bemis v. *Stevens & Bros.*, 177 Fed. 717, 721 (D. C., N. D. Illinois);
Carson v. *Amer. Smelting & Refining Co.*, 4 Fed. (2d) 463 (C. C. A. Ninth)—Certiorari denied 269 U. S. 555.

Apparently the petitioners desire to have this court review its own decision in *Carnegie* v. *Cambria* and its refusal to take the case of *Carson* v. *American Smelting Co.*, on a petition for a writ of certiorari—a ground which does not come within the reasons for granting a writ of certiorari as set forth in this Court's Rule 38.

Basically, and underlying the whole of the petition, is the complaint that the lower courts and tribunals, having heard and considered the evidence offered, adjudged that petitioners were not entitled to a patent for that which was invented by respondent's inventor. Therefore, petitioners seek to obtain another hearing in the hope that this court will come to a different conclusion on the same facts. The petition presents no substantial ground in view of this court's previous rulings on petitions of like character for the allowance of the writ herein sought. A perusal of the opinions of the District Court and the Court of Appeals and the evidence upon which these opinions were founded shows clearly that all of the questions raised by the petitioners in their present application were considered. The conclusion of the two lower courts was that the petitioners had failed to establish their claims of inventorship.

The Facts.

The recitation of the facts contained in the opinion of the District Court (R., pp. 561-562) and of the Circuit Court of Appeals (R., pp. 626-627) is concise, clear and adequate.

An interference was declared in the Patent Office between petitioners Becket and Franks and Schafmeister, respondent's inventor, which, upon proofs offered by both

sides, was determined by the Examiner of Interferences in favor of Schafmeister who refused to grant a patent to Becket and Franks. The decision of the Examiner of Interferences was affirmed by the Board of Appeals in the Patent Office. The petitioners did not then exercise their right to appeal to the Court of Customs and Patent Appeals but instituted the present suit in the United States District Court in Delaware by filing a complaint under R. S. 4915 (35 U. S. C. §63). The District Court, after trial, determined the issues against Becket and Franks (33 Fed. Supp. 324) and the Circuit Court of Appeals for the Third Circuit on appeal affirmed the District Court (122 Fed. [2d] 314). Consequently Becket and Franks have had two hearings on the merits in the Patent Office and two hearings on the merits in the courts, all four of which determined the facts and the law against Becket and Franks.

The invention involved in the interference and in the suits related to preventing internal (intergranular) corrosion in stainless steel. It had been found that stainless steel was damaged in its internal construction when subjected to certain ranges of temperature during welding and when subsequently used in chemical apparatus in certain industrial operations such as oil cracking. The means for overcoming this serious defect involved the use of columbium alone, or with tantalum.

The lower four tribunals having disposed of the case against petitioners, this court will not review such concurrent findings.

General Talking Pictures Corp. v. *Western Electric Co.*, 304 U. S. 175, 178-179. Nor will the court review by certiorari evidence or specific facts. *Southern Power Co.* v. *North Carolina Public Service Co.*, 263 U. S. 508, 509.

It is respectfully submitted that the District Court and the Court of Appeals were correct and that the present petition should be denied.

There was therefore involved in the Patent Office proceedings and in the courts below the usual question

among rival inventors as to who was the first inventor and entitled to a patent for the use of columbium or columbium with tantalum in the manufacture of stainless steel in order to overcome intergranular corrosion and the resulting collapse of the alloy under certain conditions. Petitioners, because there was a disclosure in Schafmeister's application of other rare earth metals, than columbium or columbium and tantalum, attempted to show in the courts below that such other rare earth metals would not give the desired result. This attempt was made in spite of the fact that the interference was limited only to the use of columbium or columbium and tantalum. The petitioners also attempted to induce the tribunals below to accept as evidence experiments which were made *ex parte* by the petitioners without the presence of the other party and without an invitation to the other party to attend such tests. The tribunals determined not to follow such evidence, regarding such evidence as unsatisfactory and stating that the courts were at liberty to ignore petitioners' *ex parte* tests.

The petitioners, having been uniformly defeated by the Patent Office tribunals, and the courts below, now seek a review by this court on propositions which are without merit.

Argument.

The petitioners, after four full hearings below, have been defeated on the facts and the law and the tribunals below have determined that Schafmeister, respondent's inventor, and not Becket and Franks, was the first inventor and entitled to a patent on the use of columbium or columbium and tantalum in the manufacture of stainless steels to prevent intergranular corrosion.

Petitioners in their brief assert that there is a conflict between the decision in this case and the decisions in other Circuits on certain propositions of law. This, how-

ever, is not the fact. The petitioners' brief does not point out any part of the decisions of the courts which are in conflict with the decisions of other courts. The District Court and the Court of Appeals determined the issues on the well known rule that

> "the party to an interference who shows that he reduced his invention to practice before the other is entitled to prevail" (R., p. 627).

That

> "the plaintiffs had the burden of overcoming the presumption in favor of Schafmeister" (R., p. 627).

and that the proofs were not sufficient to overcome the burden on the petitioners (R., p. 627).

The court laid down no new rule of law in conflict with prevailing decisions, as petitioners attempt to show. The courts followed the established rule of law in determining inventorship but found on the facts against Becket and Franks.

The finding of the tribunals below is well expressed in the Circuit Court of Appeals' decision (R., p. 626) as follows:

> "The plaintiffs also sought to attack Schafmeister's application on the ground (1) that it was not directed to intergranular corrosion and (2) that the plaintiffs had disproved Schafmeister's claims by tests which they had conducted. For these reasons, they claim priority whereby they are entitled to a decree in their favor. The attack on Schafmeister's application falls upon examination. The Schafmeister application discloses that his invention was directed at supplying an improved stainless steel for uses in which intergranular corrosion was the problem, such as in welding. The

second attack falls for the reason that the trial court was at liberty to ignore the plaintiffs' *ex parte* tests which allegedly showed the inefficiency of Schafmeister's claims and formulae. *Carson* v. *American Smelting & Refining Co.*, 4 Fed. (2d) 463, 465-466 (C. C. A. 9). See cases collected in *Steinfur Patents Corporation* v. *J. Meyerson, Inc., et al.*, 56 Fed. (2d) 372 at 379 (D. C. E. D. N. Y.)."

The petitioners complain because the tribunals below did not accept their *ex parte* tests in which they attempted to show that disclosures of Schafmeister's application, which were not involved in the interference, might or might not be operative. Clearly, what was not involved in the interference was not material to the issue and whether it was material or not, the tribunals below held that they would not consider *ex parte* tests on such an issue. We believe that this is the correct answer to the question raised on page 8 of the petition of the petitioners.

All of the four tribunals below considered the point whether Schafmeister could make the counts of the interference on the basis of the disclosure of his original application and their conclusions are set forth in considerable detail in the United States Circuit Court of Appeals' decision (R., pp. 624-5). The facts were determined against the petitioners on the well established rules of law as to priority.

CONCLUSION.

It is respectfully submitted that there is no merit in the Petition for Writ of Certiorari and that the petition accordingly should be denied.

Respectfully submitted,

ROBERTS B. LARSON,
Counsel for Respondent.